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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,413	11/21/2003	Kenneth Nelson	513-2	3417
24336	7590	03/18/2010	EXAMINER	
TUTUNJIAN + BITETTO, P.C.			ALVAREZ, RAQUEL	
20 CROSSWAYS PARK NORTH				
SUITE 210			ART UNIT	PAPER NUMBER
WOODBURY, NY 11797			3688	
			MAIL DATE	DELIVERY MODE
			03/18/2010	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/719,413	NELSON ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Raquel Alvarez	3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 1/13/2010.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-3,5-12 and 14-21 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-3,5-12 and 14-21 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date _____.	6) <input type="checkbox"/> Other: _____ .

## DETAILED ACTION

1. This office action is in response to communication filed on 1/13/2010.
2. Claims 1-3, 5-12, 14-21 are presented for examination.

### **Claim Rejections - 35 USC § 102**

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-2, are rejected under 35 U.S.C. 102(b) as being anticipated by Plotnick et al (2002/0144262 hereinafter Plotnick).

With respect to claims 1-2, Plotnick teaches a method for playing back a digital media file on a digital media play back apparatus (abstract).

determining a designated type associated with said digital media file (i.e. the media type maybe a video, audio, streaming such as music, video, movies etc.(paragraph 0090 and figure 1);

and playing back said digital media file including a required advertising block in accordance with said determined designated type of said digital media file on the play back apparatus (i.e. based on digital programming 100, playing the required advertisement blocks 110 and 120. For example different advertisements block based on the programming type such an audio ad for audio programming and the like)(Figure 1 and paragraph 0091);

wherein the play back apparatus is configured to automatically replay said advertising block in response to receiving a user-command to institute a trick play operation for scanning through a time segment of the media file that is adjacent to said

advertising block (i.e. replaying ads from the advertising blocks if the user skips or fast forwards through the programming)(paragraphs 0093 and 0094).

**Claim Rejections - 35 USC § 103**

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3, 5-12, 14-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Plotnick.

Claim 3 further recites having different prices based on the forced advertising playback modes. Plotnick teaches different forced advertising playback modes, for example forcing the users to view the ads at the beginning, the middle or at the end of the programming (placing the ads at the beginning or end of the content)(paragraph 0170 and Figure 1). Plotnick doesn't teach the consumer paying a different price based on the selection of what advertisement playback mode the user wants to receive during the programming. Official Notice is taken that it is old and well known for customers and the like to pay different prices based on their inconvenience. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the well known teachings of the consumer paying a different price based on the level of inconvenience placed on the user for example, in the case of Plotnick placing the ad in the middle will inconvenient the customer more than if the ads are

placed at the end of the programming and allowing the user to be discounted accordingly in order to compensate the users for their inconvenience.

With respect to claims 5-7, Plotnick further teaches advertising data that must be viewed at least one before, after and at least once during playback of said media file, after a user has fast forwarded through said predetermined portion of said digital media (i.e. replaying ads from the advertising blocks if the user skips or fast forwards through the programming, the ads being placed before or after playback of said media file (paragraphs 00093 0094 0170 and Figure 1).

With respect to claim 8, Plotnick further teaches further teaches wherein said advertising data is fixed (i.e. default advertisements sent to everyone connected to the system)(paragraph 0176).

With respect to claim 9, Plotnick further teaches wherein said advertising data is periodically updated in accordance with a user profile from an advertising data server (i.e. targeted ads based on user's profile)(paragraphs 0134 and 0161).

With respect to claim 10, Plotnick further teaches wherein said digital media file is provided on a removable storage medium (i.e. pre-recording the digital programming on cassettes, CDs or DVDs)(paragraph 0091).

With respect to claim 11, Plotnick further teaches the digital media file is downloaded via a computer network (i.e. the programming and the ad being delivered via the Internet)(paragraph 0178).

Claim 12 is similar in scope as the combination of claims 1 and 3 and therefore is rejected under similar rationale.

Claims 14-16 are similar in scope as claims 5-7 and therefore rejected under the same rationale.

Claim 17 is similar in scope as claim 8 and therefore rejected under the same rationale.

Claim 18 is similar in scope as claim 9 and therefore rejected under the same rationale.

Claim 19 is similar in scope as claim 10 and therefore rejected under the same rationale.

Claim 20 is similar in scope as claim 11 and therefore rejected under the same rationale.

With respect to claim 21, Plotnick further teaches wherein said digital media is stored locally, updated and prepared for retail (i.e. pre-recording the digital programming on cassettes, CDs or DVDs for distribution and sale)(paragraph 0091).

**Response to Arguments**

6. Applicant's arguments with respect to claims 1-3, 5-12, 14-21 have been considered but are moot in view of the new ground(s) of rejection.

**Conclusion**

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**Point of contact**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert A. Weinhardt can be reached on (571)272-6633. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Raquel Alvarez/  
Primary Examiner, Art Unit 3688

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R.A.  
3/13/2010

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